

Application Serial No. 10/620,038
Reply to Office Action dated August 23, 2006

**EXPEDITED HANDLING PROCEDURE
PURSUANT TO 37 C.F.R. § 1.116**

REMARKS/ARGUMENTS

**RECEIVED
CENTRAL FAX CENTER**

NOV 22 2006

In the Final Office Action of August 23, 2006, the Examiner rejected claims 78-81 under 35 U.S.C. § 112, first paragraph. Initially, the Applicant respectfully disagrees with the positions taken by the Examiner in this regard. For instance, with respect to the springback limitations, the Examiner correctly points out that the specification discloses a springback factor of a minimum of 20% and up to 50%. The Applicant claimed a springback factor having a minimum of 20%. Clearly, this language is in the specification and, if read in a vacuum, could be interpreted to cover 20-100%. However, claims cannot be read in a vacuum such that this interpretation would be improper. A similar argument could be made concerning the bulk compressibility factor limitations. Regardless, in order to further the prosecution in this case, the Applicant has amended the claims to recite the ranges of bulk compressibility and springback factor identified by the Examiner and specifically disclosed in paragraphs 0053 - 0055 of the Applicant's specification so as to be clearly supported by the specification as filed.

With respect to the rejection of claims 1-36, 38 and 79-81 under 35 U.S.C. § 103(a) as being unpatentable over Zietlow et al. (U.S. Patent No. 6,207,216) in view of Igoe (Dictionary of Food Ingredients, 4th Edition), the Applicant continues to disagree as to the application of prior art in this case. A factor relevant in considering proper motivation to modify prior art is when the prior art teaches away from the claimed invention. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the Applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). The Applicant respectfully submits that the Zietlow et al. reference clearly teaches away from adding a softening agent. For example, the background of Zietlow et al. discusses dried marshmallow bits for use in cereals, stating that "[t]hese dried marshmallow pieces exhibit **desirable crisp, frangible eating qualities...** Generally, dried marshmallow pieces soften but do not dissolve upon exposure to cold milk and rapidly lose their **desirable crisp and frangible eating qualities**. Efforts have thus been made at

Application Serial No. 10/620,038
Reply to Office Action dated August 23, 2006

**EXPEDITED HANDLING PROCEDURE
PURSUANT TO 37 C.F.R. § 1.116**

extending the bowl life of dried marshmallow pieces in cold milk, i.e., to lessen their propensity to soften in cold milk." Emphasis added. See column 1, lines 35-36, and column 2, lines 11-16 of Zietlow et al. The Zietlow et al. reference clearly does not want to create a soft marshmallow and actually addresses "the problem of softening" by formulating dried marshmallows that dissolve quickly in cold water or milk. The Examiner points to the broad statement in Zietlow et al. that the marshmallow of Zietlow et al. can comprise 0.01-25% of additional materials for the improvement of the organoleptic and visual properties of the final food product. See column 4, lines 43-49. However, nowhere in Zietlow et al. is there a suggestion to add a softening agent. Indeed, one would be hard pressed to argue that the organoleptic or visual properties of the Zietlow et al. confection would be improved by the addition of a softening agent, as the reference teaches the desirability of obtaining crisp, frangible eating qualities. **Simply stated, one of ordinary skill in the art would not at all look to add a softening agent to a product desired to be crisp and frangible.**

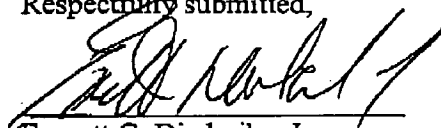
It is true that slight adjustments to the amount of a component in a product may be obvious to one of ordinary skill in the art. However, here, the main reference used by the Examiner does not contain the component of interest (a softening agent) at all. This is not a case of simply adjusting a component in a composition. It is true that the prior art teaches utilizing a softening agent in marshmallows. However, the marshmallow in Zietlow et al. has distinctly different properties from a standard marshmallow. There is no motivation provided by the prior art to add a softening agent to the **dried quick dissolving** marshmallow of Zietlow et al. In fact, adding such an agent would actually destroy Zietlow et al. Many different food additives and ingredients are available; however, that does not mean that there is motivation to combine any or every one of them with the marshmallow of Zietlow et al. As stated by the Federal Circuit: "[o]bviousness cannot be established by combining the teachings of the prior art to product the claimed invention, absent some teaching suggestion or incentive supporting the combination." *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Application Serial No. 10/620,038
Reply to Office Action dated August 23, 2006

**EXPEDITED HANDLING PROCEDURE
PURSUANT TO 37 C.F.R. § 1.116**

Based on the above, it is requested that both the formal and prior art rejections be withdrawn, the claims allowed and the application passed to issue. If the Examiner continues to disagree with the Applicant regarding the 35 U.S.C. § 103(a) rejection, the Applicant respectfully requests that the 35 U.S.C. § 112 rejections be withdrawn in view of the claim amendments in order to simplify matters for appeal. If the Examiner should have any additional concerns regarding the allowance of the application that can be readily addressed, she is cordially invited to contact the undersigned at the number provided below in order to further expedite the prosecution.

Respectfully submitted,



Everett G. Diederiks, Jr.
Attorney for Applicant
Reg. No. 33,323

Date: November 22, 2006
DIEDERIKS & WHITELAW, PLC
12471 Dillingham Square, #301
Woodbridge, VA 22192
Tel: (703) 583-8300
Fax: (703) 583-8301